

REMARKS

The final Office Action mailed on June 19, 2003 and the references cited therewith have been carefully reviewed and considered. By this amendment, no claims have been added, amended or canceled, such that claims 1-15, 17, 19 and 20 remain pending.

Rejection under 35 U.S.C. § 102

Claims 1, 3, 5, 6, 8, 10, 12, 13, 15, 17, 19 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,205,005 to Heath (hereinafter "Heath").

Independent claim 1 recites, among other limitations, "at least two leaves . . . transversely disposed at an angle to one another." The final Office action states on page 3 that Heath's elements 7, 21 are transversely disposed to one another. However, the broadest interpretation of the term "transverse" requires that the elements cross one another. See, e.g., The American Heritage College Dictionary 1438 (3d ed. 1993) ("Situated or lying across; crosswise"). Heath's elements 7, 21 clearly do not cross one another. For at least this reason, it should be clear that claim 1 is not anticipated by Heath; as such, withdrawal of the rejection as to claim 1 is respectfully requested.

Claims 3, 5 and 6 depend from claim 1 and are similarly allowable. However, some of these claims are allowable for additional reasons.

Moreover, regarding claim 5, the Examiner states that it is "inherent" that Heath's pivot axis and actuator center of mass are coincident. The Office continues to demonstrates a clear misunderstanding of inherency. The Examiner seems to be suggesting that this feature is desirable and thus should be inherent. While the feature is in fact desirable, as described in the present specification, it certainly cannot be described as "inherent."

Similarly, independent claim 8 recites, among other limitations, "at least two leaves . . . transversely disposed at an angle to one another." For the same reasons as those set forth above with respect to the rejection of claim 1, it should be clear that claim 8 is not anticipated by Heath; as such, withdrawal of the rejection as to claim 8 is

respectfully requested.

Claims 10, 12 and 13 depend from claim 8 and are similarly allowable, and the rejection of claim 12 is respectfully traversed for the same reasons as those set forth above with respect to claim 5.

Claim 15 recites "means for pivotably coupling the actuator to the base." This claim thus invokes 35 U.S.C. § 112, sixth paragraph. Whatever the result may have been under prior PTO practice, the PTO must construe functional limitations in accordance with the corresponding structure disclosed in the specification when examining patents. In re Donaldson, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994) (en banc). Applicant's corresponding structure at the least includes first and second flexible leaves transversely dispose with respect to one another within the actuator cavity. For reasons set forth above with respect to the rejection of claim 1, it should be clear that Heath does not disclose this feature. As such, claim 15 is not anticipated by the prior art, and withdrawal of the rejection under § 102(b) is respectfully requested, as is allowance of claim 15.

Claims 17, 19 and 20 depend from claim 15 and are similarly allowable.

Rejection under 35 U.S.C. § 103

Claims 4 and 11 were rejected as being obvious over Heath in view of U.S. Patent 6,404,727 to Rao (hereinafter "Rao") and U.S. Patent 4,478,532 to Puro (hereinafter "Puro").

Claims 4 and 11 are allowable by virtue of their dependence from claims 1 and 8, which are allowable for reasons set forth above. However, these claims are allowable for additional reasons.

Claims 4 and 8 recite "washers secured to each of the leaves." As acknowledged by the Office on page 4, Heath does not disclose a pair of washers secured to each leaf. The Office goes on to suggest that Rao discloses screws, and Puro discloses that washers are useful with screws, so it would have been obvious to apply both references to

modify Heath to "provide a snug and secure fit between the screw and the leaves." But Heath does not disclose screws. In a breathtaking display of hindsight reasoning, the Office has applied Rao to Heath for the sole purpose of creating a "rationale" for taking the washers from Puro and attaching them to Heaths device. Even the most cursory examination of Heath reveals that spring 21 is held in place by a compression force upon protrusions 22 and 23. To apply screws and washers to this element would destroy Heath's device. In view of the unsuitability of the Office's proposed modification as well as the excessive hindsight necessary to produce it, this rejection simply cannot be maintained. For at least these reasons, withdrawal of the rejection and allowance of claims 4 and 8 are respectfully requested.

Claims 5, 6, 12, 13 and 17 were rejected as being obvious over Heath as previously applied to claims 5, 6, 12 and 13 and further in view of U.S. Patent 5,267,110 to Otteson et al. (hereinafter "Otteson").

Notwithstanding the questionable practice of re-rejecting claims "in view of" an application of a reference to reject *those same claims*, claims 5 and 6 depend from allowable claim 1, claims 12 and 13 depend from allowable claim 8 and claim 17 depends from allowable claim 15. Claims 5, 6, 12, 13 and 17 are allowable for at least these reasons.

Claims 7 and 14 were rejected as being obvious over Heath in view of U.S. Patent 6,424,503 to Chin et al. (hereinafter "Chin").

Claims 7 and 14 depend from claims 1 and 8, respectively, and are allowable for at least this reason.

Allowable Subject Matter

The Examiner is thanked for the continued indication that claims 2 and 9 include allowable subject matter. They are not being rewritten in independent form at this time because it is believed that independent claims 1 and 8 are allowable as written.

Conclusion

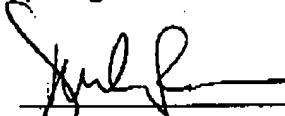
For these reasons, Applicant respectfully asserts that present claims particularly point out and distinctly claim the subject matter which is regarded as the invention. In addition, the present invention as claimed is not taught by the prior art of record or any combination thereof. This response raises no new issue for consideration and/or search, and is believed to place the application in condition for allowance; entry and consideration for this response is therefore respectfully requested. Therefore, it is respectfully submitted that the pending claims are in condition for allowance, and favorable action with respect to the present application is respectfully requested.

If the Examiner is not satisfied, but minor changes would apparently put the present case in condition for allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,
Seagate Technology LLC
(Assignee of the Entire Interest)

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Date


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